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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
MAMORU TOKASHIKI : EXAMINER: PHANTANA ANGKOOL,
DAVID
SERIAL NO: 10/730,138 :
FILED: DECEMBER 9, 2003 : GROUP ART UNIT: 2175
FOR: INFORMATION PROCESSING :
APPARATUS

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a Reply to the Examiner's Answer dated February 24, 2009.

I. STATUS OF THE CLAIMS

Claims 1-18 are pending. Claims 1-18 are appealed.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1-18 are unpatentable under 35 U.S.C. § 103(a) as obvious over Naughton et al. (U.S. Pat. No. 6,344,861, hereinafter "Naughton") in view of Cunningham et al. (U.S. Pat. Pub. No. 20020011923, hereinafter "Cunningham").

III. ARGUMENT

The Examiner's Answer clarifies certain aspects of the final rejection. Nevertheless, Appellant still believes that the final rejections are improper for the reasons provided in the Appeal Brief, and for the following additional reasons, which address points raised in the Examiner's Answer.

Appellant submits that the record clearly shows (1) that Naughton clearly teaches away from the claimed invention and (2) that Cunningham is **not** used to operate or control a device remotely. Thus, the record clearly shows that all of the claimed elements are not met by the applied art, either individually or in combination, and the art would not suggest the missing elements due to the clear teaching away.

A. Naughton and Cunningham fail to disclose or suggest the claimed “display control means” as defined in independent Claim 1, and the claimed “display device” as defined in independent Claim 10.

1. The first rationale for obviousness in the Examiner's Answer.

With regard to the statements on page 7, lines 2-10, of the Examiner's Answer, Appellant is aware that Cunningham was relied upon (and not Naughton) as allegedly teaching the claimed “display control means.” Indeed, the discussion beginning on page 9 of Appellant's Appeal Brief lays the foundation for Appellant's teaching away argument, as argued at the bottom of page 9, and further, serves as the basis for Appellant's argument regarding the technical difficulty required to convert the communications in Naughton from “intelligent remote devices” to Internet protocol. These arguments with regard to Naughton are then summarized on page 14 of the Appeal Brief. Moreover, the arguments presented on pages 9-10 and 14 of the Appeal Brief are not in contradiction to the Examiner's position that Cunningham was relied upon for the claimed “display control means.”

2. The second rationale for obviousness in the Examiner's Answer.

The Examiner's Answer maintains the previous rebuttal that Naughton and Cunningham render the claimed invention obvious. Indeed, the Examiner's Answer concedes on page 7 that Naughton does not specifically mention communication over an Internet. In light of this admission, the Examiner's Answer relies on the phrase "to go from a spreadsheet to retrieve email, a user moves from the accounting room to the mail room" in the background art section (at col. 2, lines 42-46) of Naughton as allegedly suggesting such communication.

In short, the Examiner's Answer posits the suggestion of Internet communication in Naughton. However, Naughton suggests that use over the Internet is, in fact, **not** intended, nor possible, as communication takes place directly between the device to be controlled and the remote control itself using the protocols of those devices. That is, Naughton **teaches away** from communication between the device to be controlled and the remote control being done over the Internet. After *KSR*, the Federal Circuit has recognized that contrary teachings in the prior art must be considered. For example, in *In re Sullivan*, 84 USPQ2d 1034 (Fed. Cir. 2007), the Federal Circuit vacated the PTO Board determination of obviousness, and noted that, even if a *prima facie* allegation of obviousness is made, the PTO must consider evidence "that the prior art teaches away from the claimed invention in any material respect." 84 USPQ2d at 1038 citing *In re Peterson* 315 F3d 1325, 1331 (Fed. Cir. 2003).

In another recent post-KSR case, the Federal Circuit recognized that the teaching, suggestion, or motivation test (TSM) should not be rigidly applied, but that a flexible TSM test remains a "primary guarantor against a non-statutory hindsight analysis." More particularly, in *Ortho-McNeil Pharmaceutical Inc. v. the Mylan Laboratories, Inc.*, 86 USPQ2d 1196, 1201-1202 (Fed. Cir. 2008), the Federal Circuit affirmed the district court finding of nonobviousness, recognizing:

As this court has explained, however, a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis such as occurred in this case. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 [84 USPQ2d 1929] (Fed. Cir. 2007) (“[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention.”). The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence – teachings, suggestions (a tellingly broad term), or motivations (an equally broad term) – that arise before the time of invention as the statute requires.

In this case, the record amply supports the district court's finding of nonobviousness. This court detects no rigid application of the evidentiary requirements for obviousness in the district court's analysis. ... *Of particular importance beyond the prima facie analysis, this court also detects evidence of objective criteria showing nonobviousness.*

For the facts of record, Appellant has clear, objective evidence that Naughton teaches away from the claimed invention.

The Examiner's Answer fails to establish a *prima facie* case of obviousness, in that *the Examiner's Answer completely ignores the fact that the Naughton reference teaches contrary to communication between the device to be controlled and the remote control being done over the Internet.* The only support provided by the Examiner's Answer for the allegation that one skilled in the art would proceed contrary to the teachings of the cited references in order to arrive at the present invention is the Examiner's Answer's conclusory statement that “the Internet may be and is a communication medium by which [the Naughton] system may operate.”

It appears that the Examiner is taking a position that the Internet must be inherent in Naughton. Yet, inherency is not based on a mere probability of what could or may have happened in Naughton. Indeed, M.P.E.P. § 2112 states that inherency may not be established by probabilities or possibilities. In fact, the only relevant statement in the reference itself (“to go from a spreadsheet to retrieve email, a user moves from the accounting room to the mail

room”) does not suggest communication between a device to be controlled and a remote control being done over the Internet. Accordingly, it is respectfully submitted that consideration of Naughton demonstrates the non-obviousness of the present invention.

Moreover, *assuming arguendo* that the mention of the word “email” in the Naughton reference is enough to suggest communication over the Internet, the technological difficulties which would dissuade one of ordinary skill in the art at the time of the invention from modifying Naughton to actually use Internet transmission for communication to take place between the device to be controlled and the remote control are not addressed, either in the Naughton reference nor in the Examiner's Answer. Indeed, as noted at the top of page 10 of Appellant's Appeal Brief, if the communications in Naughton were somehow placed on the Internet, the protocol of the information being transmitted in the intelligent remote devices would have to first be reformatted for Internet transmission and later be converted back to the required protocols for the local devices.

3. The third rationale for obviousness in the Examiner's Answer.

The Examiner's Answer maintains the previous assertion that paragraph [0027] of Cunningham allegedly suggests transmitting information over the Internet to communicate with an item to be operated. However, the Examiner's Answer does not include an articulated response to Appellant's argument in the Appeal Brief that any actual use of the Internet in Cunningham is a mere transfer of information to a device, and is **not** used to operate or control a device remotely. Rather, the Examiner's Answer repeats the previous inaccurate interpretation of paragraph [0027] in Cunningham.

As noted on pages 11 and 12 of Appellant's Appeal Brief, paragraph [0027] in Cunningham states that “[t]he controllers 50 and 60 may also be coupled *to an external communications network* (e.g., the internet, world wide web) via telephone, DSL or cable

TV lines 35 or the like, or via a wireless link such as cellular telephone, satellite or the like.”

[Emphasis added]. Later, Cunningham states:¹

The system of the present invention, via *the console 50*, or other such system controller, *can interact with networks such as the Internet* in context-specific and targeted modes that are heretofore unprecedented. Via the console 50, the system of the present invention can *browse the Internet and access information therefrom as a function of the operational state of the system and/or of information gathered by the system*. For example, when a user is accessing a recipe on a recipe website, the user can add all or some of the listed ingredients to a shopping list by pressing the touchscreen next to or on the respective ingredients. Selected ingredients may also have manufacturers' discount coupons attached thereto. Once completed, the user can electronically send the shopping list, with coupons, to an on-line grocer for processing, payment and delivery. *The list can also be printed* at a printer coupled to the system (e.g., via the PC 59) *or uploaded to a PDA via the IR interface 280 or other serial data interface of the console 50*. Once in the PDA, the list can then be downloaded to a receiving system at a grocery store for processing.

Accordingly, Cunningham contemplates using console 50 as collecting and downloading information from selected websites, and may provide personalized homepages for users to storing personal information such as memos and weight and blood pressure information obtained from devices in the house, such as scale 72 or BP monitor 76. Thus, Appellant reiterates that any actual use of the Internet is a mere transfer of information to a device and is **not** used to operate or control a device remotely. Hence, even if the Internet feature of Cunningham is applied to Naughton, then the combination will still fail to produce the claimed transmission of information over the Internet to communicate with said item to be operated. Rather, such a combination would only mean that the remote control system in Naughton is now connected to the outside world by the Internet.²

In summary, Appellant submits that (1) Naughton clearly teaches away from the claimed invention and (2) that Cunningham relied on in the Examiner's Answer for operating

¹ Cunningham et al. numbered paragraph [0069].

² See the paragraph bridging pages 11 and 12 of Appellant's Appeal Brief.

or controlling a device remotely merely teaches the transfer of information to a device and is **not** used to operate or control a device remotely. Thus, all of the claimed elements are not met by the applied art, either individually or in combination, and the art would not suggest the missing elements due to the clear teaching away.

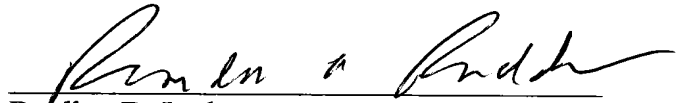
Accordingly, the Final Action fails to make a *prima facie* case of obviousness. It is respectfully requested that the rejection of Claims 1-18 be reversed.

B. Conclusion

In view of the foregoing, it is respectfully submitted that the cited references, whether considered alone or in combination, fail to disclose or suggest the combined features set forth in Claims 1-18. Accordingly, it is respectfully requested that the rejection of Claims 1-18 be reversed.

Respectfully submitted,

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